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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,892	10/26/2001	Howard E. Preissman	PALX-003DIV	8727
24353	7590	05/11/2004		
BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025				
			EXAMINER PRIDDY, MICHAEL B	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/039,892	PREISSMAN, HOWARD E.	
	Examiner	Art Unit	
	Michael B Priddy	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 5-14 and 28-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15-27 and 38-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20031028</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species E, Figs. 11-12c, in Paper No. 20040223 is acknowledged. An action on the claims readable thereon, 1-4, 15-27 and 38-42, follows.

### ***Claim Objections***

Claims 15-19, 21-23 and 25-27 are objected to because of the following informalities: in line 2, "for" should be --on--. Appropriate correction is required.

Claim 20 is objected to because of the following informalities: in line 3 of claim 20, --to-- should be inserted between "affixed" and "said first column". Appropriate correction is required.

Claim 21 is objected to because of the following informalities: in line 1, "threads" should be --threading--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 15-18, 20-23, 25-27 and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Perler (U.S. 4,863,072). Perler teaches a high pressure applicator for driving the delivery of a flowable tissue implant material, comprising: a first column 12 having an inner wall, an outer wall, a first end, a second end having an orifice 44 for delivering implant material therethrough; a second column 14, said second column being drivable with respect to said first column to generate a pressure within said first column 12; and a handle 16 attached to said first column 12 and radially extending therefrom to provide a user mechanical advantage upon grasping said handle 16; at least one O-ring 23 mounted to an end portion of said second column 14 and interfacing with said inner wall of said first column 12; wherein said second column 14 comprises a wall which is drivably engageable with one of said inner and outer walls; a handle 18 integrally formed with or affixed to and extending radially from said second column 14 to provide the user a mechanical advantage upon grasping said handle 18; threading 38 on at least a portion of said inner wall of said first column 12, wherein said wall of said second column 14 is an external wall comprising threading 22 along at least a portion thereof, said threading 22 of said external wall being engageable with said threading 38 on at least a portion of said inner wall; wherein said threading 22 covers only a portion of said second column 14 external wall, an end portion of said second column 14 being relatively smooth; wherein only a portion of said inner wall comprises threads, the remainder 46 of said inner wall being substantially smooth; wherein said relatively smooth end portion comprises a reduced diameter section 48 having an outside diameter less than an inside diameter of said threads 38 on said inner wall, and

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an enlarged section 24 which closely fits with said substantially smooth inner wall 46 to form a pressure seal therewith; wherein said pressure seal is enhanced by said O-ring 23.

Concerning the limitations of claims 38-42 which require the applicator be capable of generating pressures of at least about 1000psi; 1500psi; up to about 2000psi; 2500psi; and/or 3000psi, it is the Examiner's view that since the structure of Perler is fully functionally equivalent if not identical to that claimed, the applicator of Perler is capable of generating the pressures claimed.

Claims 1 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (U.S. 5,603,701). Fischer teaches a high pressure applicator for driving the delivery of a flowable tissue implant material, comprising: a first column 12 having an inner wall, an outer wall, a first end and a second end having an orifice for delivering implant material therethrough; a second column 16, said second column being drivable with respect to said first column 12 to generate a pressure within said first column 12; and a handle 28 attached to said first column 2 and radially extending therefrom to provide a user a mechanical advantage upon grasping said handle 28; wherein said first column 12 comprises a removable section 14 adapted to be removed from said first column 12 for drivably engaging said first 12 and second 16 columns.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perler in view of Phillips (U.S. 4,032,118). Perler, as presented above, teaches all of the limitations of the present invention except the at least one sealing element comprises a Teflon wrap.

Phillips teaches a sealing means for stirring apparatus. The sealing means 10 comprises a sleeve 12 having internal threads and a stopper 18 comprising external threads 17 complementary to internal threads on sleeve 12. Teflon tape 34 is placed on threads 17 to enhance the seal between sleeve 12 and stopper 18. It would have been obvious to one of ordinary skill in the art at the time of the present invention to apply the Teflon tape of Phillips to the threads 22 or 38 of Perler to enhance the seal between the first and second columns.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 10/310,354. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the present application is anticipated by claim 8 of the '354 application.

The difference between claim 1 of the present invention and claim 8 of the '354 application lies in the fact that claim 8 includes more elements (a piston member having a base and head,...) and is thus more specific than the present application. Thus the invention of claim 8 is, in effect, a "species" of the "generic" invention of claim 1. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

*Michael B. Priddy*  
May 6, 2004